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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,187	03/31/2004	Naoki Naruse	9683/185	7511
757	7590	10/12/2006	EXAMINER	
BRINKS HOFER GILSON & LIONE			VY, HUNG T	
P.O. BOX 10395			ART UNIT	
CHICAGO, IL 60610			PAPER NUMBER	

2163

DATE MAILED: 10/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/815,187

Applicant(s)

NARUSE ET AL.

Examiner

Hung T. Vy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/29/2004 and 03/31/2004</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Summary of claims

1. Claims 1-4 are pending.
Claims 1-4 are rejected.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 10/29/2004 and 03/31/2004.
The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Specification

3. The specification has been checked to the extent necessary to determine the presence of possible minor errors. However, the applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 4, line 4, the phrase "of said cache memory means, and content storage means for storing content" renders the claim indefinite because it does not fit into the context. It is also uncertain how cache memory means and content storage means are used with the rest of the elements and steps presented in the preamble of the independent claims.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 4 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basic of this rejection is set forth in a test of whether the invention is categorized as a process, machine, manufacture or composition of matter and if the invention produces useful, concrete and tangible result. Mere ideas is the abstract idea, law of nature, natural phenomena) are found to be non-statutory subject matter. For a method claim to pass muster, the recites process must produce a useful, concrete and tangible result.

In the present case, claim 4 recite a program product for causing a computer to execute are merely software per se. Since a program product for causing a computer of claim 4 is software per se and do not contain any physical components, a program product for causing a computer can not be categorized in one of the statutory categories of invention and is thus nonstatutory.

To expedite a complete examination of the instant application, the claims reject under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

Further, claim 4, the a program *product for causing a computer* does not produce a useful, concrete and tangible result as set forth in 2106 (IV)(B)(2)(b)(ii), e.g., *a process of limiting functions realized through processing or execution by said content using means on the basic of a determination of said determining means* is not a tangible result because *a process of*

limiting function is not a program product for causing a computer to execute as recited in the preamble. The claim invention does not produce a useful because the claim does not meet the requirement as recited in the preamble, e.g., *a program product for causing a computer to execute*. The claim invention does not produce a useful because the claim does not provide what is the result, what is final result that is concrete, useful and tangible?

Because the “practical application, result, concrete, useful and tangible” limitations are not claimed in Applicant’s claims, Examiner believes that the above listed claims are nonstatutory.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4 are rejected under 35 U. S. C. § 102 (e) as being anticipated by Tanaka (U.S. Patent. 6,735,768).

With respect to claims 1 and 4, with best understood, Tanaka discloses an information processing device having cache memory means, acquiring means for acquiring contents which realize a function through processing or execution (column 2, line 10+, or column 3, line 40+), first writing means for writing contents acquired by the acquiring means in a free space or a space (26)(see column 4, line 28+), and it is inherent that where some data is already stored, of said cache memory means, and content storage means for storing contents because all computer

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has a cash to storing contents of frequency accessed RAM (see column 2, line 52) locations and the addressed where these data items are stored, said information processing device comprising: estimating means, when instructed to process or execute contents, for estimating whether said contents are for trial use (generating code D by performing an operation P)(S5)(see column 2, line 23+ or column 5, line 46+), by determining in which of said cache memory means and said content storage means said contents are stored (26)(see fig. 2 and column 6, line 4+, and line 27+); content using means for reading contents instructed to be processed or executed from said cache memory means or said content storage means (26) (see column 6, line 49), and processing or executing said contents; determining means, when contents are processed or executed by said content using means (what kind of generate code for this software)(lock, unlock) (see column 2, line 23+), for determining whether to limit functions realized through processing or execution of said contents, on the basis of an estimation of said estimating means and function limit information showing a rule (lock, unlock)(see column 2, line 23+) regarding limits on functions realized through processing or execution by said content using means (see column 2, line 23+); and limiting means for limiting functions realized through processing or execution by said content using means on the basis of a determination of said determining means (see column 2, line 23).

With respect to claim 2, Tanaka discloses when said estimating means estimates that said contents are for trial use (code K and D)(see column 2, line 25), said determining means determines to limit said functions of said contents; and when said estimating means estimates that said contents are not for trial use, said determining means determines to disobey said function limit information (unlock by code K and D)(see column 2, line 24+).

With respect to claim 3, Tanaka discloses comprising operation means; deleting means, when a command is issued using said operation means for deleting contents stored in said content storage means, for freeing a storage space for storing said contents (see column 9, line 64); and second writing means for writing contents acquired by said acquiring means in a free space or a storage space freed by said deleting means (recorded)(see column 9, line 64), wherein said acquiring means acquires said contents via communication (28)(see fig. 2) .

Conclusion


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung Vy whose telephone number is (571) 272-1954. The examiner can normally be reached on Monday-Friday 8:30 am - 5:30pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on (571) 272-1834. The fax numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 308-7722 for After Final communications.

Information regarding the status of an application may be obtained from the patent Application Information Retrieval (PAIR) system. Status information for published application may be obtained from either private Pair or Public Pair. Status information for unpublished applications is available through Private Pair only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have question on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hung T. Vy
Art Unit 2163
September 22, 2006.

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